

ESTTA Tracking number: **ESTTA511748**

Filing date: **12/19/2012**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

## Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

### Opposer Information

Name	Bata Brands S.a.r.l. Luxembourg, Succursale De Lausanne
Granted to Date of previous extension	12/19/2012
Address	Avenue De Rhodanie 70 Lausanne, 1007 SWITZERLAND

Attorney information	John Clarke Holman, Robert S. Pierce Jacobson Holman PLLC 400 7th St., NW Washington, DC 20004 UNITED STATES trademark@jhip.com, rpierce@jhip.com, jholman@jhip.com Phone: 202-638-6666
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### Applicant Information

Application No	85569536	Publication date	08/21/2012
Opposition Filing Date	12/19/2012	Opposition Period Ends	12/19/2012
Applicant	Sundek, LLC 3950 Executive Park Blvd., SE Southport, NC 28461 UNITED STATES		

### Goods/Services Affected by Opposition

Class 025. First Use: 1969/01/10 First Use In Commerce: 1969/01/10

All goods and services in the class are opposed, namely: Clothing, namely, swimsuits, boardshorts, sweatshirts, knit shirts, t-shirts, tank tops, jackets, coats, dresses, dress shirt, pants, capri pants, and shorts; footwear; headwear

### Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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### Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	975546	Application Date	08/11/1972
Registration Date	12/25/1973	Foreign Priority Date	NONE
Word Mark	SANDAK		
Design Mark			

Description of Mark	NONE
Goods/Services	Class U039 (International Class 025). First use: First Use: 1961/09/00 First Use In Commerce: 1970/06/00 FOOTWEAR

Attachments	I06644 opposition notice.pdf ( 9 pages )(275686 bytes )
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### **Certificate of Service**

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Robert S. Pierce/
Name	Robert S. Pierce
Date	12/19/2012

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re the applications of:

Sundek, LLC  
Serial No. 85569536  
Mark: SUNDEK  
Filed: March 14, 2012

BATA BRANDS S.A.R.L. LUXEMBOURG, )  
SUCCURSALE DE LAUSANNE, )

Opposer, )

v. )

SUNDEK LLC, )

Applicant. )

Opposition No: \_\_\_\_\_

**CONSOLIDATED NOTICE OF OPPOSITION**

Opposer, Bata Brands S.a.r.l. Luxembourg, Succursale De Lausanne  
(hereinafter Bata), believes that it will be damaged by the registration of the mark  
shown in the above-identified application and hereby opposes same.

As grounds for opposition, Bata alleges:

1. Bata Brands S.a.r.l. Luxembourg, Succursale De Lausanne is a  
corporation organized under the laws of Luxembourg, located and doing business at  
Avenue De Rhodanie 70, Lausanne 1007, Switzerland.

2. Upon information and belief, Sundek, LLC (hereinafter Sundek) is a  
limited liability company organized under the laws of North Carolina, located and doing  
business at 3950 Executive Park Blvd., SE, Southport, North Carolina 28461.

3. Upon information and belief, Sundek filed a trademark application for SUNDEK in standard characters on March 14, 2012, based on actual use the mark on “[c]lothing, namely, swimsuits, boardshorts, sweatshirts, knit shirts, t-shirts, tank tops, jackets, coats, dresses, dress shirt, pants, capri pants, and shorts; footwear; headwear ” in International Class 25. The application was accorded Serial No. 85569536 and published for opposition in the Official Gazette on August 21, 2012.

4. Bata timely filed a Request for a 90-day Extension of Time to oppose Serial No. 85569536 on September 1, 2012. The Trademark Trial and Appeal Board granted this request. This opposition is timely filed by the close of the 90-day opposition period on December 19, 2012.

5. Beginning before the filing date of Sundek’s application, Bata and its predecessors and licensees (hereafter referred to collectively as “Bata”) have, and are now, engaged in selling footwear in commerce in the United States, under and in connection with the trademark SANDAK in standard characters. Bata continuously has used its SANDAK Mark in commerce in connection with Bata’s products, advertised, offered for sale, and sold by Bata, and to identify and designate same, and to distinguish those goods, services and business from those of others.

6. Bata is the owner of, and will rely on herein, the following U.S. trademark registration for its SANDAK Mark as used in connection with its footwear:

<u>Mark</u>	<u>Registration No.</u>	<u>Issue Date</u>
SANDAK	975,546	December 25, 1973

This registration is valid and subsisting, and constitutes *prima facie* and/or conclusive evidence of Bata’s ownership of the SANDAK Mark, and exclusive right to use same in

commerce in connection with the goods set forth in the registration. Copies of the foregoing registration and its status are attached hereto as Exhibit A.

7. Since Bata's initial use of its SANDAK Mark, it has used, advertised, produced, and offered its footwear under and in connection with this mark to the public, through various channels of trade, and in commerce, with the result that Bata's customers and the public in general have come to know and recognize Bata's mark and associate same with Bata and/or the footwear produced, advertised, marketed, distributed, and sold directly or indirectly by Bata and its businesses. Bata thus has built up goodwill in connection with the sale of its footwear under its SANDAK Mark such that Bata's mark is identified, associated, and/or equated by Bata's customers, the trade, and the public.

8. Upon information and belief, the SUNDEK Mark sought to be registered by Sundkek is substantially similar and/or a colorable imitation of, and so resembles Bata's previously used SANDAK Mark as to be likely, when used for the identical and related goods of Sundek identified in Serial No. 85569536, to cause confusion or mistake or to deceive customers, the trade, and the public in general, thereby resulting in damage and detriment to Bata, its SANDAK Mark, and reputation.

9. On information and belief, the clothing, footwear, and headwear identified in the opposed application are identical or related to the footwear sold under and/or in connection with Bata's SANDAK Mark, and upon information and belief, Bata and Sundek both are, or could be, engaged in the marketing, selling, and promoting of their respective goods through the same and/or related channels of trade, and/or to the same and/or related class(es) of customers.

10. On information and belief, people having knowledge, familiarity with, and/or who have participated in, consumed, obtained, and/or bought Bata's footwear sold under and/or in connection with its SANDAK Mark, as well as the public and trade in general, are likely to be confused, mistaken, or deceived as to the origin, sponsorship, and/or association of Sundek's clothing, footwear, and headwear marketed, sold, and/or promoted under SUNDEK Mark sought to be registered by Sundek, and misled into believing Sundek's clothing, footwear, and headwear emanate from, or in some way, directly or indirectly, are associated with Bata to the damage and detriment of Bata and its reputation.

11. Bata believes that the registration of Serial No. 85569536 on the Principal Register will impair its rights in its SANDAK Mark inasmuch as Sundek's mark is substantially similar and/or a colorable imitation of, and so resembles Bata's SANDAK Mark and Sundek's clothing, footwear, and headwear identified in the opposed application is identical, and/or similar in nature, and/or related to the services and related goods sold under and/or in connection with Bata's SANDAK Mark. Thus, the opposed applications are causing or will cause injury to Bata.

WHEREFORE, Opposer, Bata Brands S.a.r.l. Luxembourg, Succursale De Lausanne, believes and alleges that it will be damaged by the registration of the SUNDEK Mark and therefore prays that:

- (a) the Notice of Opposition herein be sustained in favor of Bata Brands S.a.r.l. Luxembourg, Succursale De Lausanne; and
- (b) the registration of applications Serial No. 85569536 be rejected and refused.

Respectfully submitted,

Bata Brands S.a.r.l. Luxembourg, Succursale  
De Lausanne

By: /Robert S. Pierce/  
John C. Holman  
Robert S. Pierce  
Attorneys for the Opposer  
JACOBSON HOLMAN PLLC  
400 Seventh Street, Northwest  
Washington, District of Columbia 20004  
(202) 638-6666

**CERTIFICATE OF SERVICE**

I hereby certify that a copy of the foregoing ***Notice of Opposition*** was served on this 19<sup>th</sup> day of December 2012, addressed to:

1) By first class mail, postage prepaid

Nicolette R. Hudson  
Barnes & Thornburg LLP  
21 East State Street, Suite 1850  
Columbus, Ohio 43215-42197  
Applicant's Attorney of Record

/Robert S. Pierce/

# United States Patent Office

975,546  
Registered Dec. 25, 1973

## PRINCIPAL REGISTER Trademark

Ser. No. 432,582, filed Aug. 11, 1972

**SANDAK**

Calzado Sandak, S.A. (Mexican corporation)  
Calzada Tulyehualco No. 125-A  
Mexico City 13, Mexico

For: FOOTWEAR, in CLASS 39 (INT. CL. 25).  
First use in or about September 1961; in commerce in  
or about June 1970.

JACOBSON HOLMAN  
PLLC  
EXHIBIT

A



STATUS DOCUMENTS

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Mark: SANDAK

US Serial Number: 72432582

Application Filing Date: Aug. 11, 1972

US Registration Number: 975546

Registration Date: Dec. 25, 1973

Register: Principal

Mark Type: Trademark

Status: The registration has been renewed.

Status Date: Feb. 21, 2006

**Mark Information**

Mark Literal Elements: SANDAK

Standard Character Claim: No

Mark Drawing Type: 1 - TYPESET WORD(S) /LETTER(S) /NUMBER(S)

**Goods and Services****Note:**

The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((...)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks \*..\* identify additional (new) wording in the goods/services.

For: FOOTWEAR

International Class: 025

U.S Class: 039 - Primary Class

Class Status: ACTIVE

Basis: 1(a)

First Use: Sep. 1961

Use in Commerce: Jun. 1970

**Basis Information (Case Level)**

Filed Use: Yes

Currently Use: Yes

Amended Use: No

Filed ITU: No

Currently ITU: No

Amended ITU: No

Filed 44D: No

Currently 44D: No

Amended 44D: No

Filed 44E: No

Currently 44E: No

Amended 44E: No

Filed 66A: No

Currently 66A: No

Filed No Basis: No

Currently No Basis: No

**Current Owner(s) Information**

Owner Name: BATA LIMITED

Owner Address: 59 WYNFORD DRIVE  
NORTH YORK (TORONTO), ONTARIO M3C 1K3  
CANADA

Legal Entity Type: CORPORATION

State or Country Where CANADA  
Organized:**Attorney/Correspondence Information****Attorney of Record**

Attorney Name: JOHN CLARKE HOLMAN

**Correspondent**

**Correspondent** JOHN CLARKE HOLMAN  
**Name/Address:** JACOBSON HOLMAN PLLC  
400 SEVENTH ST NW  
WASHINGTON, DISTRICT OF COLUMBIA 20004-2201  
UNITED STATES

**Domestic Representative - Not Found**

### Prosecution History

Date	Description	Proceeding Number
Aug. 20, 2008	CASE FILE IN TICRS	
Feb. 21, 2006	REGISTERED AND RENEWED (SECOND RENEWAL - 10 YRS)	70132
Feb. 21, 2006	REGISTERED - SEC. 8 (10-YR) ACCEPTED/SEC. 9 GRANTED	
Jun. 30, 2003	REGISTERED - COMBINED SECTION 8 (10-YR) & SEC. 9 FILED	
Jun. 30, 2003	PAPER RECEIVED	
Oct. 14, 1993	REGISTERED AND RENEWED (FIRST RENEWAL - 10 YRS)	
Jan. 21, 1980	REGISTERED - SEC. 8 (6-YR) ACCEPTED	

### Maintenance Filings or Post Registration Information

**Affidavit of Continued Use:** Section 8 - Accepted  
**Affidavit of Incontestability:** Section 15 - Accepted  
**Renewal Filed:** Yes  
**Renewal Date:** Dec. 25, 2003

### TM Staff and Location Information

**TM Staff Information - None**

#### File Location

**Current Location:** SCANNING ON DEMAND

**Date in Location:** Aug. 20, 2008

### Assignment Abstract of Title Information

#### Summary

**Total Assignments:** 2

**Registrant:** CALZADO SANDAK, S.A.

**Conveyance Filter**

#### Assignment 1 of 2

**Conveyance:** ASSIGNS THE ENTIRE INTEREST AND THE GOODWILL

**Reel/Frame:** 0437/0797

**Pages:** 1

**Date Recorded:** Mar. 28, 1983

**Supporting Documents:** No Supporting Documents

#### Assignor

**Name:** CALZADO SANDAK, S. A.

**Execution Date:** Oct. 12, 1982

**Legal Entity Type:** CORPORATION

**State or Country Where** MEXICO

**Organized:**

#### Assignee

**Name:** BATA LIMITED

**State or Country Where** CANADA

**Legal Entity Type:** CORPORATION

**Organized:**

**Address:** 59 WYNFORD DRIVE  
DON MILLS, ONTARIO M3C 1K3, CANADA

#### Correspondent

**Correspondent Name:** HOLMAN AND STERN

**Correspondent Address:** 2401 15TH ST., N. W.  
WASHINGTON, DC 20009

**Domestic Representative - Not Found**

#### Assignment 2 of 2

**Conveyance:** ASSIGNS THE ENTIRE INTEREST

Reel/Frame: 2914/0556

Pages: 4

Date Recorded: Feb. 05, 2004

Supporting Documents: assignment-tm-2914-0556.pdf**Assignor**Name: BATA LIMITED

Execution Date: Feb. 05, 2004

Legal Entity Type: CORPORATION

State or Country Where CANADA

Organized:

**Assignee**Name: BATA BRANDS S.A.R.L. LUXEMBOURG, SUCCURSALE DE LAUSANNE

Legal Entity Type: CORPORATION

State or Country Where LUXEMBOURG

Organized:

Address: AVENUE DE RHODANIE 70  
LAUSANNE, SWITZERLAND 1007**Correspondent**

Correspondent Name: JACOBSON HOLMAN PLLC

Correspondent Address: JOHN C. HOLMAN  
400 SEVENTH STREET, N.W.  
WASHINGTON, D.C. 20004-2218

Domestic Representative - Not Found